

REMARKS

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of April 2, 2009, which reopened prosecution of claims 22, 23 and 26 after a final decision of the Board of Patent Appeals and Interferences in light of new prior art being applied to the claims. Claims 6-7, 9-10, 20 and 27 have been cancelled.

Reconsideration of the Application is requested in view of the comments and amendments herein.

I. The Office Action

Claims 6-7, 9-10, 20 and 27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Elkins (D244,558) in view of Elkins (4,128,242), Viollaz (U.S. 5,447,311), and Motomiya.

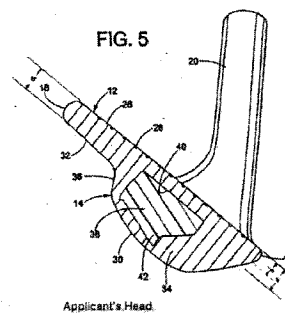
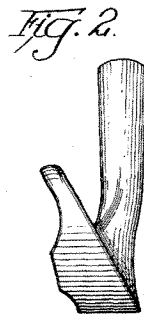
Claims 22-23 and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Elkins (D244,558) in view of Elkins (4,128,242), Behrendt (D164,469), Viollaz (U.S. 5,447,311), and Motomiya.

II. The Claims Distinguish Patentably Over the References

Independent claim 22 teaches a golf club head including a thin sole, a top edge, a hosel, a front surface defining a strike face, a rear surface that is opposite the front surface, a muscle back portion interposed between the front surface and the muscle back surface and defining a cavity disposed toward an upper portion of the muscle back portion, and an insert comprising a high-rebound material disposed in the cavity. A large portion of the muscle back portion is positioned under the cavity so that mass is still concentrated towards the bottom of the club head and the cavity is not visible from the exterior of the golf club. The rear surface includes an at least substantially flat blade surface and a contoured muscle back surface. The blade surface extends to the top edge and the muscle back surface, which is near the sole. The distance between the front surface and the rear surface adjacent the top edge is greater than the distance between the front surface and the rear surface adjacent the sole.

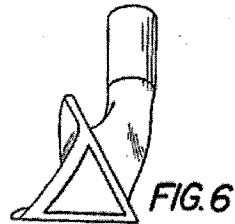
In light of the reversal of the Examiner's rejection by the BPAI, the Examiner now sets forth a new ground of rejection. The Examiner acknowledges that Elkins ('242) lacks a muscle back surface having an upper ledge that generally follows the contour of the top edge, a muscle back portion covering at least half of the surface area of the rear surface, a thin sole in which the

distance between the front surface and the rear surface adjacent the sole is less than the distance between the front surface and the rear surface adjacent the top edge, a cavity disposed in a muscle back portion with the cavity not visible from the exterior of a club and having no visible cavity thereon, a substantial portion of the extra mass portion being positioned below the cavity, or an elastomer at least substantially filling a cavity and an elastomer being a polyurethane. However, the Examiner asserts that Behrendt discloses an iron with a blade surface and a muscle back surface having a thin sole and the distance between the front surface and the rear surface adjacent the sole is less than the distance between the front surface adjacent the top edge as measured by the Applicant which is approximately perpendicular from the striking face surface. Applicant respectfully disagrees.



As shown above (left), Fig. 2 of Behrendt discloses a golf head with a blade surface, muscle back surface, and a wide sole. Compared to Fig. 5 of the present specification (above right), the sole of the Behrendt golf head is not thinly defined and rather has no distinct definition in which to measure the distance between front surface and rear surface adjacent to the sole. Rather, the sole extends straight out from the front face to the rear surface. Although Behrendt may disclose a point at the front of the intersection between the front face and the sole, the sole is wide and straight at the bottom of the club head. In fact, the Behrendt design is comparable to that of Elkins, as shown below. Elkins explains that a “wide ‘sweep’ sole” is provided to lower the center of gravity of each club head and increase the loft of the club at impact without significant sacrifice in the distance of carry of the ball. As held by the Board of Patent Appeals and Interferences, “Elkins does not show a distance between the front surface and the rear surface adjacent the top edge being greater than a distance between the front surface and the rear

surface adjacent the sole.” See pages 11-12 of the Decision on Appeal. Additionally, as stated above, on page 6 of the 04/02/2009 Office Action, the Examiner agrees that Elkins does not show this claimed feature.



Accordingly, since Behrendt fails to disclose a thin sole having the presently claimed, and above-mentioned features, modifying the head of Elkins would not result in the subject invention. As such, it is respectfully submitted that independent claim 22, along with claims 23 and 26 dependent therefrom, is now in condition for allowance.

CONCLUSION

For the reasons detailed above, it is respectfully submitted that the subject claims 22, 23, and 26 are now in condition for allowance.

Respectfully submitted,

Fay Sharpe LLP

A handwritten signature in black ink, appearing to read 'Scott A. McCollister', is written over a horizontal line.

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Date

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